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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,247	12/06/2001	Juergen A. Kortenbach	SYN-064B	5785

24131 7590 01/25/2005

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EXAMINER

PANTUCK, BRADFORD C

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/010,247

Applicant(s)

KORTENBACH ET AL. 

Examiner

Bradford C Pantuck

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 25-32 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-24 and 33-38 is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-11, 13, 14, 39, and 40 is/are rejected.
- 7) ☒ Claim(s) 5 and 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>See Continuation Sheet</u> .           |

Continuation of Attachment(s) 6). Other: Attachment A from U.S. Patent 5,707,392.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-4, 6-11, and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,707,392 to Kortenbach. Regarding Claims 1, 2, 8, 10, Kortenbach discloses a forceps capable of applying clips, having a hollow member (15), a clevis (34) coupled to the distal end of the hollow member, and forceps jaws (36, 38) rotatably coupled to the clevis [Column 1, lines 52-55; Figures 2 and 10]. Each jaw [see Fig. 7] has a longitudinal extent. A longitudinal extent is considered to be something that extends longitudinally, which is considered to encompass a broad range of things. Each jaw has a channel (55), which extends along the longitudinal axis of the jaw. This channel (55) is most certainly capable of applying a surgical clip.

Prior art Figure 2 shows a device, with which Kortenbach's invention is meant to be used. Figure 2 shows push/pull wires (18, 19) coupled to the jaws, and it is evident that there is an actuation means at the proximal ends of these wires so that the user could actuate them [Column 1, lines 61-65]. Each jaw (51) has teeth capable of puncturing tissue, as shown in Figure 7.

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2. Regarding Claims 3, 4, 6, 7, 11, and 13, each channel is cup shaped [Column 4, lines 7-11] and will therefore be hook shaped at the distal end of channel (55) and will be able to provide the function of an anvil were a clip to be inserted therein.
3. Regarding Claim 9 and 14, at some point in the curved cup part of jaw (51), the angle will be 22 degrees relative to the vertical axis.
4. Claims 39 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,354,312 to Brinkerhoff et al. Brinkerhoff discloses a device, which has a hollow member (42) and a clevis (65) coupled to the distal end of the hollow member [see Column 4, lines 17-22; Fig. 3]. *The device is intended to be used endoscopically* [Column 1, lines 1-11]. There is a first jaw (46) rotatably coupled to the clevis (65), and a second jaw (48) rotatably coupled to the clevis (65) [Fig. 3; Column 4, lines 20-22]. The two jaws oppose each other, as shown in Fig. 2. Brinkerhoff's invention includes a pull/push wire (54), which is coupled to the jaws (46, 48) and extends through the hollow member (42) to its proximal end [see Fig 2; Column 4, lines 23-31]. Wire (54) is capable of both pushing and pulling the jaws into respective open and closed positions [Column 4, lines 29-31].

Next, Brinkerhoff discloses actuation means (44, 56, 58) coupled to the proximal end of the hollow member and the proximal end of the push/pull wire. The actuation means moves the push/pull wire through the hollow member to cause the jaws to rotate between an open and a closed position [see Fig. 2; Column 4, lines 7-11].

Additionally, his instrument has a linkage (66), which has a rotating element (66) that is rotatably coupled to the clevis (65) and coupled to the push/pull wire (54) [see Column 4, lines 18-31]. Each linkage provides mechanical advantage in rotating the end effector, because each linkage holds each respective jaw (48 or 46) further out on each jaw (48 or 46), which diminishes the mechanical work that must be done on each jaw to open and close it. Rotating element (66) is coupled at coupling junction (78) to the end effector.

#### *Allowable Subject Matter*

5. Claims 5 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
6. Claims 15-24 and 33-38 are allowed.

#### *Conclusion*

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from

the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

*Response to Arguments*

8. Regarding independent claims 1 and 10, Applicant's arguments filed November 23, 2004 have been fully considered but they are not persuasive. Regarding independent claims 1 and 10, Examiner disagrees with Applicant's assertion that "the Kortenbach jaws 51, 151 do not define a channel and cannot apply, guide, fit, or even hold a surgical clip" [Remarks, p. 32]. Each of Kortenbach's jaws 51 has a trough-shaped channel 55, especially evident in Figures 7 and 8. A channel is defined as "a trench, furrow, or groove," a definition which Kortenbach's channel 55 surely meets.

Examiner can easily imagine a c-shaped resilient clip that could fit within the forceps jaws of Kortenbach's device and be applied (slidingly) to tissue. Reference is made to Attachment A [Attached to this document], in which Examiner has drawn such a clip, as are well known in the art. Although Kortenbach's device is not intended for such an intended use, as the jaws close, the distal ends of the clip will slide into the distal end of each channel 55, being pushed into tissue. One end of the clip could have a clasp in order to catch the other arm of the clip, maintaining the clip in the closed position after application.

9. Examiner maintains his opinion that teeth 52 of Kortenbach's device are capable of puncturing tissue, especially the tender, soft stomach tissue of the human body, contrary to Applicant's assertions on page 34 of "Remarks."

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10. Applicant's arguments, see the first paragraph of page 38 in "Remarks", filed November 23, 2004, with respect to the rejection of claims 15-24 and 33-38 have been fully considered and are persuasive. The rejection of claims 15-24 and 33-38 has been withdrawn.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradford C Pantuck whose telephone number is (571) 272-4701. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BCP  
BCP

January 12, 2005

ANHTUAN T. NGUYEN  
PRIMARY EXAMINER

1/20/05



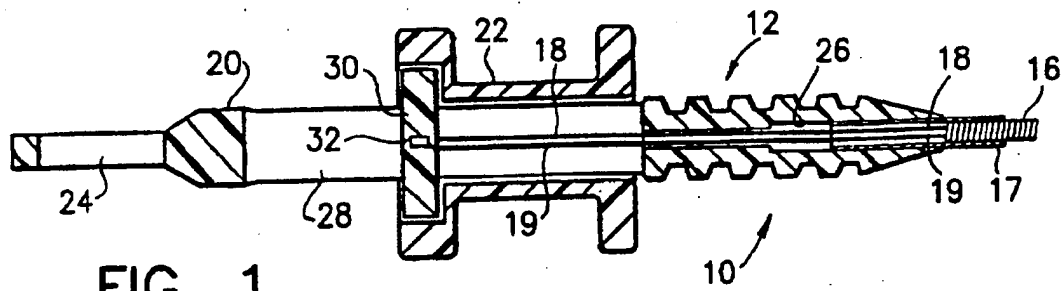


FIG. 1  
PRIOR ART

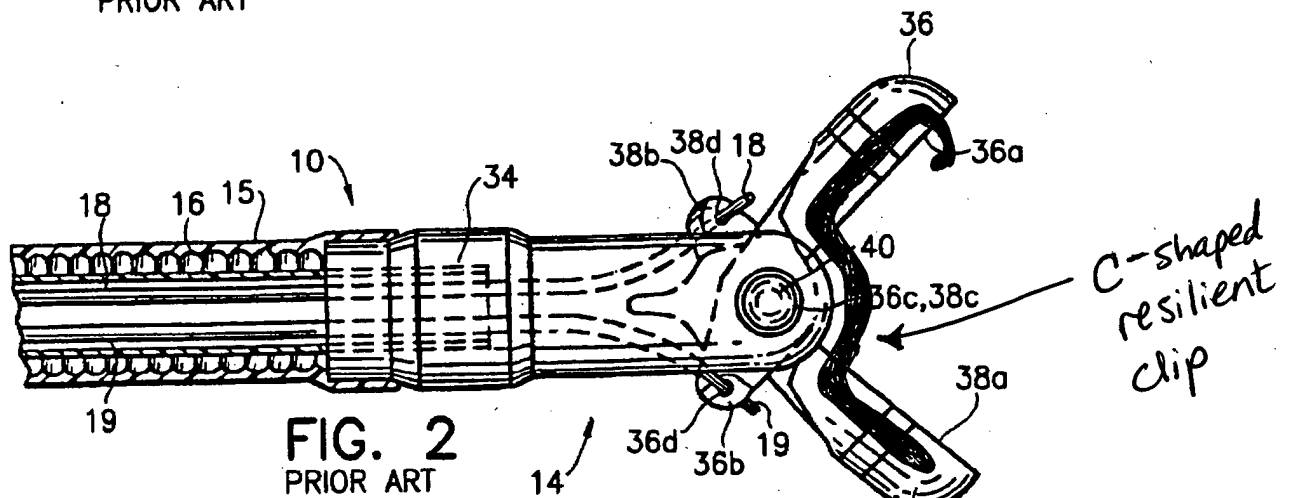


FIG. 2  
PRIOR ART

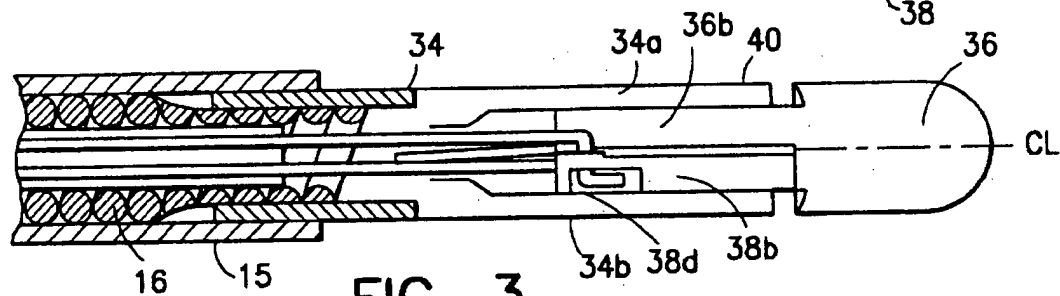


FIG. 3  
PRIOR ART

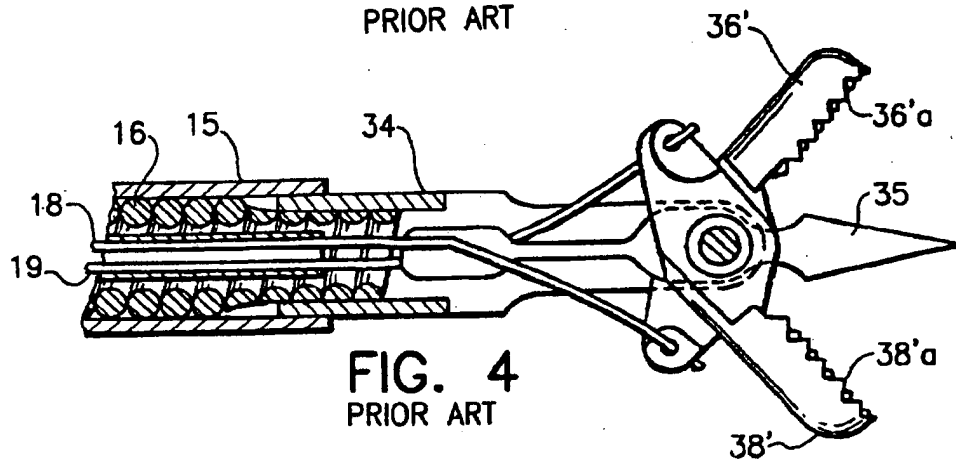


FIG. 4  
PRIOR ART